

# CARPMAELS & RANSFORD

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26. Juni 2008

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YOUR REF 05 712 282.2

OUR REF P044400EP: JAW/MAB/els

23rd June 2008

Dear Sirs,

Re: European Patent Application 05 712 282.2  
CEPHALON, INC.

I refer to the communication pursuant to Rule 70(2) EPC dated 15th May 2008 issued in connection with this application. I hereby state that the Applicant does indeed wish to proceed further with this application.

Yours truly,

  
WARNER, James Alexander

Carpmaels & Ransford, Professional Association No. 182



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GRANDE BRETAGNE

For any questions about  
this communication:  
Tel.: +31 (0)70 340 45 00

Date
15.05.08

Reference P044400EP:HG	Application No./Patent No. 05712282.2 - 2103 PCT/US2005002782
Applicant/Proprietor CEPHALON, INC.	

**Proceeding further with the European patent application pursuant to Rule 70(2) EPC**

A supplementary European search report has been drawn up concerning the above European patent application (publication number 1718607).

Since a request for examination has been filed (R. 70(1) EPC) and the examination fee has been paid (Art. 94(1) EPC) prior to the transmission of the supplementary European search report, you are hereby invited to indicate within

**two months**

of notification of this invitation whether you desire to proceed further with the European patent application.

If you do not indicate in due time that you desire to proceed further with the European patent application, it will be deemed to be withdrawn (R. 70(3) EPC).

If you wish you may comment on the supplementary European search report and amend, where appropriate, the description, claims and drawings (R. 70(2) EPC).

**Receiving Section**





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For any questions about  
this communication:  
Tel.: +31 (0)70 340 45 00

Date
28.04.08

Reference P044400EP:HGH	Application No./Patent No. 05712282.2 - 2103 PCT/US2005002782
Applicant/Proprietor CEPHALON, INC.	

### Communication

The European Patent Office herewith transmits as an enclosure the supplementary European search report under Article 153(7) EPC for the above-mentioned European patent application.

If applicable, copies of the documents cited in the European search report are attached.

- ☒ Additional set(s) of copies of the documents cited in the European search report is (are) enclosed as well.

### Refund of the search fee

If applicable under Article 9 Rules relating to fees, a separate communication from the Receiving Section on the refund of the search fee will be sent later.





DOCUMENTS CONSIDERED TO BE RELEVANT			
Category	Citation of document with indication, where appropriate, of relevant passages	Relevant to claim	CLASSIFICATION OF THE APPLICATION (IPC)
X	"Provigil (modafinil) tablets [C-IV]" FDA APPROVED LABELING TEXT FOR NDA 20-717/S-005 & S-008, 23 January 2004 (2004-01-23), pages 1-35, XP002475473 * page 3, lines 1-13 * -----	1-3,13, 14,20,21	INV. C07C317/48 C07C315/06 A61K31/165
X,L	EP 0 233 106 A (LAFON LABOR [FR]) 19 August 1987 (1987-08-19) * page 7, line 26 - page 12, line 21 * -----	1-3,13, 14,20,21	
			TECHNICAL FIELDS SEARCHED (IPC)
			C07C A61K
The supplementary search report has been based on the last set of claims valid and available at the start of the search.			
Place of search Munich		Date of completion of the search 10 April 2008	Examiner Pérez Carlón, Raquel
<b>CATEGORY OF CITED DOCUMENTS</b> X : particularly relevant if taken alone Y : particularly relevant if combined with another document of the same category A : technological background O : non-written disclosure P : intermediate document T : theory or principle underlying the invention E : earlier patent document, but published on, or after the filing date D : document cited in the application L : document cited for other reasons & : member of the same patent family, corresponding document			



### CLAIMS INCURRING FEES

The present European patent application comprised at the time of filing more than ten claims.

- ☐ Only part of the claims have been paid within the prescribed time limit. The present European search report has been drawn up for the first ten claims and for those claims for which claims fees have been paid, namely claim(s):
- ☐ No claims fees have been paid within the prescribed time limit. The present European search report has been drawn up for the first ten claims.

### LACK OF UNITY OF INVENTION

The Search Division considers that the present European patent application does not comply with the requirements of unity of invention and relates to several inventions or groups of inventions, namely:

see sheet B

- ☐ All further search fees have been paid within the fixed time limit. The present European search report has been drawn up for all claims.
- ☐ As all searchable claims could be searched without effort justifying an additional fee, the Search Division did not invite payment of any additional fee.
- ☐ Only part of the further search fees have been paid within the fixed time limit. The present European search report has been drawn up for those parts of the European patent application which relate to the inventions in respect of which search fees have been paid, namely claims:
- ☐ None of the further search fees have been paid within the fixed time limit. The present European search report has been drawn up for those parts of the European patent application which relate to the invention first mentioned in the claims, namely claims:
- ☒ The present supplementary European search report has been drawn up for those parts of the European patent application which relate to the invention first mentioned in the claims (Rule 164 (1) EPC).



The Search Division considers that the present European patent application does not comply with the requirements of unity of invention and relates to several inventions or groups of inventions, namely:

1. claims: 1-3, 13(part), 14, 20(part)-21(part)

compositions comprising 2:1 R:S modafinil, their synthesis  
and method of treatment using them  
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2. claims: 4-6, 13(part), 15, 20(part)-21(part), 22

R-(-)-modafinil form III, preparation and use  
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3. claims: 7-9, 13(part), 17, 20(part)-21(part), 28-30

R-(-)-modafinil form V, preparation and use  
---

4. claims: 10-12, 13(part), 16, 20(part)-21(part), 27

R-(-)-modafinil form IV, preparation and use  
---

5. claims: 23-26

solvates of R-(-)-modafinil  
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The only linking concept among the different independent claims are crystalline forms of modafinil and their enantiomers, that are already state of the art (see for example EP-233106 or W002/10125) together with their use for the treatment of narcolepsy. This feature is therefore not a special technical feature in the sense of Rule 44 EPC.

**ANNEX TO THE EUROPEAN SEARCH REPORT  
ON EUROPEAN PATENT APPLICATION NO.**

EP 05 71 2282

This annex lists the patent family members relating to the patent documents cited in the above-mentioned European search report.  
The members are as contained in the European Patent Office EDP file on  
The European Patent Office is in no way liable for these particulars which are merely given for the purpose of information.

10-04-2008

Patent document cited in search report		Publication date	Patent family member(s)			Publication date
EP 0233106	A	19-08-1987	CA	1274543 A1		25-09-1990
			DE	3760201 D1		06-07-1989
			DK	49687 A		01-08-1987
			FR	2593809 A1		07-08-1987
			GR	3000128 T3		29-11-1990
			IE	59832 B1		06-04-1994
			JP	1980171 C		17-10-1995
			JP	6102623 B		14-12-1994
			JP	62190160 A		20-08-1987
			US	4927855 A		22-05-1990
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Date  
04.04.07

Reference  
P044400EP:HG

Application No./Patent No.  
05712282.2-2101-US2005002782

Applicant/Proprietor  
CEPHALON, INC.

### Refund of fees

The following fee was paid in respect of the application 05712282.2:

Fee	Code	Voucher No	Date	Currency	Amount
Renewal fee	033	00566345	31.08.06	EUR	400,00
Renewal fee	033	00207833	27.02.07	EUR	400,00

According to the present state of the file the refund will be made by:

CREDITING THE DEPOSIT ACCOUNT 28050059.

Amount refundable:	Code	Currency	Amount	Voucher No
	033	EUR	400,00	00259283

Reason for refund: Fee paid twice.

The Authorising Officer  
Aitken  
(49)(89)23992735

